

Appl. No. 10/789,566

Request for Reconsideration dated December 7, 2005

Reply to Office Action dated September 7, 2005

REMARKS/ARGUMENTS

Claims 1 - 17 are in the application for consideration. Reconsideration of the application is requested.

1. Claims 1 - 15 (it should be noted that claims 1 - 17 are in the application) have been rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 16 of co-pending application serial no. 10/789,600. In support of the rejection the examiner has asserted

Although the conflicting claims are not identical, they are not patentably distinct from each other because the applications claim compounds that are structurally similar with the exception of the oxygen-containing group in position R6 of the '600 application. However, as claimed, the R6 position of that application may be an oxygen-containing group, therefore it would have been obvious to one of ordinary skill in the art to prepare the material of the 10/789600 application with reasonable expectation of achieving a compound, imaging member, or imaging method as instantly claimed.

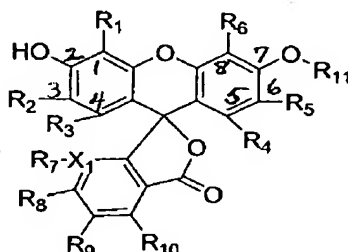
Applicants traverse this ground of rejection. The compounds recited in present claims 1 - 17 are not obvious in view of the compounds recited in the claims of the '600 application.

For the purposes of discussion applicants' generic formula I will be reproduced here with the positions on the central ring moiety numbered to facilitate the discussion of the differences between the compounds of applicants and those of the reference.

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The R6 substituent of the compounds of the '600 application is in the 7 position. The substituent in the 7 position of the present compounds is defined as -O-R₁₁ where R₁₁ is selected from the members of a specified Markush group. Thus, the respective claimed compounds can have oxygen-containing substituents in the 7 position.

However, there is a significant difference between the respective compounds. The present compounds have an -OH group in the 2 position whereas the compounds of the '600 application have an -OH:A group in the 2 position where A is defined as a hydrogen-bond accepting group.

Obviousness-type double patenting rejections involve claims in an application which define merely obvious variations of subject matter claimed in a patent or in this case an application. In considering whether this condition is present only the claims of the patent may be relied upon. Here the claims of the '600 application do not suggest the compound recited in the present claims. There is no suggestion to be found in such claims which would provide any incentive to one skilled in the art to remove the hydrogen bond-accepting group from those

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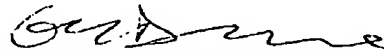
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compounds. Thus, the rejection is not properly supported by the claims of the '600 application.

Reconsideration of this ground of rejection and withdrawal thereof are respectfully requested.

In summary the claims are proper in form for allowance and in substance have been shown to be wholly novel and patentably distinguishable over the claims of the '600 application. Reconsideration of the application and allowance of the claims are respectfully requested.

Respectfully submitted,



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